



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,288	06/27/2001	Kayo Teramoto	040894-5683	1847

9629 7590 12/29/2004

MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

EXAMINER

AGUSTIN, PETER VINCENT

ART UNIT	PAPER NUMBER
----------	--------------

2652

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/891,288

Applicant(s)

TERAMOTO, KAYO

Examiner

Peter Vincent Agustin

Art Unit

2652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 6 and 9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 6 and 9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, 6 & 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yonemitsu in view of Kurano & Park.

In regard to claims 1 & 3, Yonemitsu discloses a recording medium reproduction apparatus (figure 2) for reproducing a DVD recording medium (20, see also column 1, line 8: "video disc") in which recorded data and table of contents data including recording medium side reproduction restriction information for restricting reproduction of the recorded data is recorded (column 6, lines 14-21), said recording medium reproduction apparatus comprising: recording means/member in which apparatus side reproduction restriction information related to recording medium side reproduction restriction information is recorded (column 5, lines 45-51); information reading means/member which reads the apparatus side reproduction restriction information recorded in said recording means/member (figure 5, step S102) and also reads the recording medium side reproduction restriction information from the recording medium (S101) before reproducing the recorded data from the recording medium; comparing means/member (S102) which compares the apparatus side reproduction restriction information with the recording medium side reproduction restriction information each read from said information reading means/member; determination means/member which determines whether reproduction

Art Unit: 2652

of the recorded data is to be allowed (S104) or not (S105) based on the comparison result of said comparing means/member; control means/member which stops reproduction of the recorded data (S105) when said determination means/member determines that the reproduction of the recorded data is not allowed; and a reproducing means/member (figure 5, step S104), wherein the recording medium side reproduction information is a region code (figure 3B: territory code). However, Yonemitsu does not disclose that the control means/member outputs and displays the recording medium side reproduction restriction information when said determination means/member determines that the reproduction of the recorded data is not allowed. Yonemitsu also does not disclose an OSD generating means/member; and a displaying means/member, wherein when said determination means/member determines that the reproduction of the recorded data is not allowed, said control means/member generates character signal related to an error signal and a recording medium side reproducing restriction information in said OSD generating means/member, and outputs and displays on said displaying means/member with superposing on a video signal.

Park discloses an OSD generating means/member (figure 6, element 310); and a displaying means/member (column 10, line 63), a character signal related to a recording medium side reproducing restriction information is generated (column 10, lines 61-64) in said OSD generating means/member, and outputs and displays on said displaying means/member with superposing on a video signal, so that the restriction information can be recognized by the user. Kurano discloses a monitor (figure 1, element 6) that displays characters indicating that parental control is being performed (figure 30, step S30), i.e., a character signal related to an error signal, in order to notify the user that reproduction is restricted. It would have been obvious to one of

Art Unit: 2652

ordinary skill in the art at the time of invention by the applicant to have displayed the restriction information of Yonemitsu using the OSD generating means/member and displaying means/member of Park, so that the restriction information can be recognized by the user. Furthermore, it would have been obvious to one of ordinary skill in the art at the time of invention by the applicant to have configured the control means/member of Yonemitsu to output and display restriction information when it is determined that reproduction is not allowed, as suggested by Kurano. The motivation would have been to notify the user that reproduction is restricted.

In regard to claims 6 & 9, Kurano, and hence the obvious combination noted above, discloses a receiving means/member (figure 1, element 6) coupled to the outside of said recording medium reproduction apparatus (as shown in figure 1), wherein when said determination means/member determines that the reproduction of the recorded data is not allowed, said control means/member outputs and displays information on said receiving means/member and on said displaying means/member (column 23, lines 13-22).

Response to Arguments

3. Applicant's arguments filed on September 1, 2004 have been fully considered but they are not persuasive.

4. In regard to page 8, paragraph 2, the applicant argues that Kurano fails to overcome the deficiency of Yonemitsu, i.e., "control means which outputs and displays the recording medium side reproduction restriction information" because Kurano discloses displaying characters on the monitor indicating that parental control is being performed, which is not the same as displaying reproduction restriction information that is contained on the optical disk. While the examiner

Art Unit: 2652

agrees that displaying characters on the monitor indicating that parental control is being performed is not the same as displaying reproduction restriction information that is contained on the optical disk, the examiner disagrees that Kurano fails to overcome this deficiency of Yonemitsu. While Kurano does not disclose displaying reproduction restriction information, it would have been obvious to display the reproduction restriction information of Yonemitsu using the display of Kurano. Since Kurano is capable of displaying parental control information, there is no reason why one of ordinary skill in the art at the time of invention would not have been able to display the reproduction restriction information of Yonemitsu. Furthermore, applicant should note that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

5. In regard to page 9, paragraph 2, the applicant argues that Park also fails to overcome the deficiency of Yonemitsu as described above because merely shows a video cassette recorded for displaying a channel which is capable of being synchronized on an OSD, and not a recording medium reproduction apparatus for reproducing a DVD recording medium; therefore, Park does not show the “control means which outputs and displays recording medium side reproduction restriction information as a region code, when reproduction is stopped”. While the examiner agrees that Park does not show the “control means which outputs and displays recording medium side reproduction restriction information as a region code, when reproduction is stopped”, the examiner disagrees that Park fails to overcome the deficiency of Yonemitsu. While Yonemitsu does not explicitly disclose an OSD generating means, it would have been obvious to use the OSD generating means of Park so that the restriction information can be recognized by the user,

Art Unit: 2652

as noted in the rejection above. Furthermore, applicant should note that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

6. In regard to page 9, last line thru page 10, line 3, the applicant argues that Park does not provide any motivation to modify the respective arrangements of Yonemitsu and Kurano to show the feature of the "control means which outputs and displays the recording medium side reproduction restriction information as a region code, when a reproduction is stopped". The examiner disagrees. Column 10, lines 63-64 of Park disclose displaying characters on a "screen" *so that they can be recognized by the user*, which is a well-known purpose of displaying, and thus, a sufficient motivation to modify the respective arrangements of Yonemitsu and Kurano.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

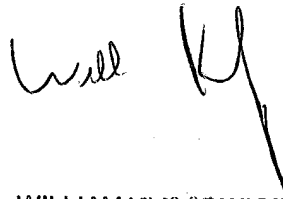
Art Unit: 2652

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Vincent Agustin whose telephone number is (703) 305-8980. The examiner can normally be reached on Monday thru Friday 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen can be reached on (703) 305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Peter Vincent Agustin
Art Unit 2652



WILLIAM KLIMOWICZ
PRIMARY EXAMINER